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**OFFICE OF PETITIONS**

In re Application of	:	
Soulanille et al.	:	DISMISSAL OF PETITION
Application No. 09/915,801	:	UNDER 37 CFR 1.78(a)(3)
Filed: July 26, 2001	:	
Attorney Docket No. 9623/338	:	

This is a decision on the petition under 37 CFR 1.78(a)(3), filed July 12, 2004, to accept an unintentionally delayed claim for the benefit of a prior application set forth in the concurrently filed amendment.

The petition is **dismissed**.

When an application is filed on or after November 29, 2000, benefit claims under 35 U.S.C. 119(e), 120, 121 and 365(c) must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. For the instant application, the above period of time ended on November 26, 2001. The priority claims at issue were not made by this date. However, petitioner has submitted a petition under 37 CFR 1.78(a)(3).

37 CFR 1.78(a)(3) states,

If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

- (i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;
- (ii) The surcharge set forth in § 1.17(t); and
- (iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

Petitioner has failed to satisfy (i) above. Specifically, a *proper* amendment adding the priority claim has not been filed. Rule 78 may not be used to incorporate by reference material which was not previously incorporated by reference. In this case, the amendment seeks to incorporate by reference the contents of application no. 09/872,737.

The petition cannot be granted until a proper amendment is filed. Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment deleting the incorporation by reference statement, along with a renewed petition under 37 CFR 1.78(a)(3), is required.

Further correspondence with respect to this matter should be addressed as follows:


By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306  
Attn: Office of Petitions

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

The file will now be forwarded to the examiner to determine if the proposed amendment raises new issues which will require further consideration and/or search.

Telephone inquiries may be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

  
Frances Hicks  
Petitions Examiner  
Office of Petitions